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By:   
Rebecca M. Whitelock

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Shigeru HOSOE et al.	)	Confirmation Number: 5811
	)	
Application No.: 10/619,110	)	Group Art Unit: 3651
	)	
Filed: July 15, 2003	)	Examiner: Mark A. DEUBLE
	)	
For: CONVEYANCE APPARATUS,	)	
CONVEYANCE SYSTEM, AND	)	
CONVEYANCE METHOD	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO ELECTION/RESTRICTION REQUIREMENT**

In an election requirement dated May 4, 2005, the Examiner required election under 35 U.S.C. § 121 of one patentably distinct species from among Figures 1-4, 5-7, 8, and 9 as Category A. In addition, the Examiner required a further selection between the systems for a glass load and a plastic load as Category B.

In response to the mandatory election of species requirement, Applicants provisionally elect, with traverse, to prosecute the subject matter of Figure 8 from Category A and further provisionally elect, with traverse, to prosecute the subject matter of "the system wherein the load is glass" from Category B.

The Examiner further required Applicants to identify all claims readable on their selections from Category A and Category B. Applicants assert that at least claims 1-4, 6-15, 17-29, and 31 are readable on the selections from Category A and Category B. Applicants also respectfully assert that all claims are generic.

Further, Applicants traverse this election of species/restriction requirement for at least the following reasons. The Examiner has made merely conclusory statements that species exist and has not meet his *prima facie* case of a proper restriction. It is not clear what element has the mutually-exclusive, varying attribute necessary to define each of the alleged species. Lastly, none of the current alleged species in Category A allow Applicants to prosecute claim 5.

The Examiner merely alleged that Species 1 is depicted in Figs. 1-4, Species 2 is depicted in Figs. 5-7, Species 3 is depicted in Fig. 8, and Species 4 is depicted in Fig. 9 (Category A). Additionally, the Examiner alleged that a claimed conveyance apparatus or method of conveying that conveys glass and the claimed conveyance apparatus or method of conveying that conveys plastic are different species (Category B). But the restriction requirement did not contain any other statement explaining why the two criteria for a proper restriction requirement were met. MPEP 803 (“(A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required.”) (citations to other MPEP sections omitted).

The Examiner failed to provide reasons and/or examples to support his conclusion that the application discloses species among which a restriction is appropriate. MPEP § 803 Guidelines. Referring to the MPEP’s initial guidance for Determination of Distinctiveness or Independence of Claimed Inventions, Applicants

point out that only “[w]here inventions are independent (i.e., no disclosed relation therebetween” is restriction ordinarily proper, MPEP 806, and with regard to species that is because “[w]here inventions are related as disclosed but are distinct as claimed, restriction may be proper.” MPEP 806 (emphasis added).

Applicants assert that neither categorization results in categories of species, and therefore the election of species/restriction requirement should be withdrawn.

Applicants understand species as having mutually exclusive variations of an element, not as having additional elements,

“Consider, for example, a patent application that discloses a three-legged stool wherein a first figure of the drawings discloses legs that taper from wide to narrow in the direction away from the seat, while in a second figure of the drawings the legs taper from narrow to wide in the direction away from the seat. The generic invention is a three-legged stool. It is appropriate to talk about a generic invention here because there are two inhabitants of that genus. The first species is a three legged stool with legs tapered in one direction while the second species is a three-legged stool with the taper in the opposite direction.

It is critical to note that species are genuine species only because each has a characteristic that is mutually exclusive to that of the other. Thus, the case of a three-legged stool tapering wide to narrow from the seat cannot be a three-legged stool tapering in the reverse direction. . . .

Claims to two species cannot be termed broader or narrower than each other although they are clearly different from each other. Furthermore, in order for mutual exclusivity to exist to thereby establish two species, the mutually exclusive qualifications must be with respect to only a single one of the elements of the genus. Moreover, that which is added cannot be in the form of an added element. Thus, the genus-species relationship can never be that of a subcombination-combination.” Kayton, Irving, “Patent Practice,” Vol. 1, pp. 3.16-3.17, 7<sup>th</sup> Ed.

Alleged Species 1, Figs. 1-4: Figs. 1-4 depict four embodiments of a single conveying apparatus. Fig. 4 discloses an embodiment of a single conveying apparatus between two parts of a molding die. Within these figures the dimensions of the taper, diameter of the through-hole, and shape of the supporting cylinder change.

Alleged Species 2, Figs. 5-7: Figs. 5-7 depict another embodiment of the conveying apparatus, which may be described as a subcombination—the combination of embodiments of the elements depicted in Figs. 1-4, with at least one additional element—a heater coiled around the supporting cylinder. Figs. 5-6 depict side and top views of one embodiment of a single conveying apparatus. Fig. 7 depicts an embodiment of a conveyance system comprising two embodiments of a conveying apparatus aligned in series under a load feeder/metering device.

Alleged Species 3, Fig. 8: Fig. 8 depicts another embodiment of the subcombination depicted in Figs. 5-7, wherein at least one additional element is a coiled heater around the supporting cylinder. Fig. 8 also depicts an embodiment of a conveyance system comprising three conveying apparatuses. Two of which are a parallel arrangement of conveying apparatuses. One of the two parallel conveying apparatuses is in series with a third conveying apparatus, which is a second embodiment of a conveying apparatus. A load feeder/metering device is positioned in series above the one of the two parallel conveying apparatuses that is in series with the third conveying apparatus.

Alleged Species 4, Fig. 9: Fig. 9 is a plot of experimental data on a graph showing the flow rate and supplied pressure of the fluid supplied through a porous

material with an opening pore rate of 21% to support a load of varying diameter (1.2, 2.6, and 7.2 mm).

As illustrated above, the groups of figures the Examiner has selected does not make clear what elements are present in the genus and what are the mutually exclusive attributes necessary for species to exist. Fig. 9 does not even depict a conveying apparatus, but data in graphical form. Obviously another figure, rather than Fig. 9, was intended, but Applicants are uncertain of how to respond to the current restriction requirement.

Moreover, no combination of Species selected from choices the Examiner has presented will allow for the prosecution of claim 5. Claim 5 adds only an additional wider taper to an existing element of dependent claim 2. It respectfully appears to Applicants that the Examiner is improperly requiring an election of species.

With regard to requiring a restriction between methods and apparatuses based on whether the load they are conveying is glass or plastic, Applicants also traverse this as an improper categorization of species. Applicants are not positively claiming the load as an element of the conveyance system and have canceled claims 15 and 16 to clarify this point.

Moreover, the Examiner has not alleged why there would be a serious burden to examine all of the pending claims together. MPEP 803. Indeed, the Examiner has failed to even state that any such burden exists. Under the current election, the examiner will be examining all but two claims. Applicants respectfully do not understand why a serious burden of examining all claims would exist, since all but claim 5 reads on alleged Species 3 from Category A, and only method claim 30 (specifying

that the load conveyed is plastic) does not read on the alleged species where the load is glass from Category B.


Accordingly, Applicants respectfully submit that the election of species requirement is improper and request that it be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 6, 2005

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